D. REMARKS

Specification

Applicants have amended the specification above to include the application serial numbers of the related cross-references.

Interview Summary

On January 26, 2005, Applicants' representative submitted an "Applicant Initiated Interview Request Form" to Examiner Gold via facsimile.

On February 1, 2005 at 2:00 PM EST, an interview was conducted via telephone between Amy Pattillo, Applicants' Representative, and Examiner Gold. No exhibits were shown, nor demonstrations conducted.

Applicants' representative and the Examiner discussed claim 1, and in particular the Examiner provided clarifications of the rejection of claim 1. The prior art cited against claim 1 is Cotten (US Patent 6,330,590) in combination with Zhao (US Patent 6,754,822). The following issues were clarified by the Examiner:

1. Applicants requested clarification of how the Examiner is interpreting the scope of (1) "a plurality of message entries" (2) "a messaging session" and how Cotten specifically teaches these elements. The Examiner responded that the scope of "a plurality of message entries" is interpreted to include more than one email message and the scope of "a messaging session" is interpreted as messages being sent or received.
2. Applicants requested clarification of whether the Examiner interprets the checksum based signature code in Cotten as the equivalent of a "watermark" and whether the Examiner interprets the process of applying a watermark to a message entry as the equivalent of calculating a checksum for the message entry. The Examiner responded that the numerical checksum signature is interpreted as a type of watermark.
3. Zhao teaches that a digital representation may contain a watermark, which is "an invisible indication of ownership which cannot be removed from the digital

representation and may even be detected in an analog copy made from the digital representation." [col. 1, lines 47-51] Applicants requested clarification of the Examiner's assertion that it would be have been obvious to one of ordinary skill in the art to modify Cotten (a checksum calculator based method that compares the checksums of emails to determine if there are multiple emails with the same checksum to detect potential spam) to use a distinguishable watermark on a message, as specified by the Examiner. In particular, Applicants requested clarification of whether the Examiner asserts that it would have been obvious to modify Cotten with Zhao to apply watermarks to e-mail messages in lieu of calculating checksums. The Examiner responded that Cotten is interpreted to teach all the elements of claim 1, but that the Examiner added Zhao to include a reference that actually teaches watermarking, and therefore that it would be obvious to modify Cotten with Zhao.

In addition, Applicants' representative and the Examiner also discussed claims 36, 51, and 54 and in particular Applicants representative requested a clarification of what portion of claims 36-56 is taught by Zhao. The Examiner responded that claims 36, 51 and 54 and the parallel system and program claims should include citations to how Zhao teaches the elements of the claims, however, these citations were inadvertently not included in the office action. Applicants' representative agreed to respond to the office action as it stands.

In conclusion, no agreement with respect to the claims was reached. Applicants are filing this response with the amended claims for further review by the Examiner.

35 USC § 103(a)

1. Claims 1-5, 8-16, 19-27, and 30-56

Claims 1-5, 8-16, 19-27, and 30-56 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cotten (US Patent Number 6,330,590) in view of Zhao (US Patent Number 6,754,822). The rejection is respectfully traversed. In particular, the Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Because the Examiner does not carry the burden of proving a prima facie case of obviousness for claims 1-5, 8-16, 19-27, and 30-56, the rejection should be withdrawn and the claims should be allowed.

Claims 1, 14, and 25

Independent method claim 1, which is representative of independent system claim 14 and independent computer program product claim 25, with regard to similarly recited subject matter and rejection, reads as follows:

> 1. (Original) A method for recording a messaging session, said method comprising the steps of:
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> applying a distinguishable watermark to a plurality of message entries within a messaging session; and
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> recording said plurality of messaging entries with said distinguishable watermark applied, such that an origin of said plurality of message entries is traceable according to said distinguishable watermark.

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. In particular, in establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In addition, in establishing a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that the Examiner does not show and the references do not teach or suggest, separately or in combination, the elements of applying a distinguishable watermark to a plurality of message entries within a messaging session and recording said plurality of messaging entries with said distinguishable watermark applied, such that an origin of said plurality of message entries is traceable according to said distinguishable watermark. In addition, Applicants respectfully assert that there is not any suggestion or motivation, either Cotten or Zhao or in the knowledge generally available to one of ordinary skill in the art, to modify or combine Cotten or Zhao.

Applying a distinguishable watermark to a plurality of message entries within a messaging session is not obvious in view of Cotten or Zhao, separately or in combination.

The Examiner cites Cotten as teaching applying a distinguishable watermark to a plurality of message entries within a messaging session at col. 2, lines 28-30. [Office Action, dated November 5, 2004, p. 2] In particular, the Examiner cites col. 2, lines 28-30 as teaching "a numerical signature identification code established for a bulk message." Col. 2, lines 28-30 teach:

> "After detection, a numerical signature identification code for that bulk message is established, preferably by calculating a checksum using a 16-bit cyclic redundancy check."

In addition to the citation by the Examiner, Applicants note that Cotten teaches establishing a numerical "signature identification code" for a bulk message for the purpose of detecting "bulk e-mail" (Cotten, col. 2, lines 21-27). In particular, Cotten teaches reading each e-mail message, eliminating the personalization and addressing (including origin addressing) portions of each e-mail message, and processing the remaining text to establish a "signature identification code" for the text alone (Cotten, col. 2, lines 21-24). Then, the system of Cotten detects "bulk e-mail" when the non-origin portions of at least two e-mail messages are identified with the same "signature identification code" and are sent to different e-mail addresses (Cotten, col. 2, lines 24-27). Therefore, Cotten's "signature identification code" calculated for a message striped of personalized or signature information is a numerical representation of the text of a message, calculated to make comparison of redundant messages simpler.

Applicants assert that Cotten does not teach applying a distinguishable watermark to a plurality of message entries within a messaging session because Cotten does not teach "a distinguishable watermark". In the interview dated February 1, 2005, the Examiner clarified that a "watermark" is interpreted as a mark that distinguishes the contents of a message, such as a "signature identification code" taught in Cotten that is a checksum calculation of the text of the message. Applicants assert that the Examiner's interpretation of the scope of the term "watermark", as merely an identifier of the contents of a message, is not well founded and that the numerical "signature identification code" of Cotten teaches away from the definition of a "watermark".

First, Applicants assert that a "watermark" identifies the ownership of a message, and not merely the contents of a message. In particular, the Microsoft Computer Dictionary defines a "digital watermark" as "a unique identifier embedded in a file to deter piracy and *prove file ownership and quality*. Digital watermarking is often used with graphics and audio files to *identify the owner's rights* to these works." Microsoft Computer Dictionary, 5th Edition, p. 160, published by Microsoft Press, 2002 (emphasis added). Further, Zhao defines a watermark as "an *individual indication of ownership* which cannot be removed from the digital representation and may even be detected in an analog copy made from the digital representation" (Zhao, col. 1, lines 47-51) (emphasis added). Moreover, the specification of the present invention indicates that watermarking includes "modifying the text, graphics, video, or audio included in a messaging session in a way such that the *origin of the messaging session is traceable and the integrity of the messaging session is later verifiable*" (Specification, p. 8, lines 19 -22) (emphasis added).

These references, which include a computing dictionary, a reference cited by the Examiner, and the specification of the present invention, identify two key characteristics of a watermark. First the references identify a watermark as an affixed identifier which "is embedded in a file", "cannot be removed from the digital representation", and "modifies the text, graphics, video or audio". Second, the references identify a watermark as an indicator of origin which can be used to "prove file ownership", is "an individual indication of ownership", and allows that "the origin of the messaging session is traceable." Therefore, because a watermark includes at least the characteristics of being affixed and indicating the origin of the file to which it is affixed, Applicants respectfully assert that the Examiner's interpretation of a "watermark" as merely an identifier of the contents of a message is not well founded.

Second, Applicants assert that the numerical "signature identification code" of Cotten teaches away from the definition of a "watermark". In particular, the numerical "signature identification code" actually taught by Cotten is merely a numerical calculation of the text of an e-mail, stripped of any origin identifying information (Cotten, col. 2, lines 21-27). Cotten's system teaches calculating the checksum for only the base text of a message so that the checksum can be compared with the checksum of other message, for identifying matching e-mail messages (Cotten, col. 2, lines 21-33). In contrast, in the present invention, a watermark

identifies the origin of the message entries to which the watermark is applied, or affixed. While Cotten teaches stripping an e-mail of origin identifiers, the present invention teaches applying an identifier that enables tracing of the origin of message entries.

Therefore, Applicants respectfully assert that because a "watermark" is an affixed identifier of origin, the numerical checksum of the text of an e-mail taught by Cotten does not teach a "watermark". Because Cotten does not teach a "watermark", Cotten does not teach applying a distinguishable watermark to a plurality of message entries within a messaging session.

After citing Cotten as teaching both steps in claim 1, the Examiner states that Cotten does not teach "the actual use of a watermark on a message entry." [Office Action, p. 3] The Examiner cites Zhao as teaching:

> "the techniques for protecting the security of digital representations and of analog forms produced from them (see abstract). Zhao teaches the use of a watermark added to digital representations to indicate ownership (col. 1, lines 47-51, col. 2, lines 12-19, lines 55-60." [Office Action, p. 3]

The Examiner concludes that:

> "it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cotten in view of Zhao to use a distinguishable watermark on a message. One would be motivated to do so because a watermark allows a message entry to be traceable." [Office Action, p. 3]

With regard to the limitations of Cotten, Applicants note that the Examiner cites Cotten as not teaching "the actual use of a watermark on a message entry", however the language of claim 1 teaches "applying a distinguishable watermark to a plurality of message entries". Applicants note that the limitation cited by the Examiner does not distinctly point out whether Cotten does not teach the "applying" or the "distinguishable watermark" and the rejection is vague as to what portion of the claim limitations the term "use" applies. Applicants respectfully traverse the rejection as though the Examiner were relying on Zhao to teach the "applying" and the "distinguishable watermark".

First, Applicants respectfully assert that Zhao teaches applying a watermark to a digital representation, not multiple message entries within a messaging session. Thus, while Zhao does teach the application of a watermark, Zhao does not teach applying a watermark to multiple message entries within a messaging session. Furthermore, Applicants respectfully note that

Zhao does not teach or suggest applying a watermark to multiple message entries within a messaging session or modifying the watermarking of digital representations to apply watermarking to multiple message entries within a messaging session.

Second, Applicants respectfully assert that when the references and claim 1 are considered as a whole, it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify Cotten in view of Zhao because Cotten's system is not concerned with identifying the origin of an email. Cotten's system is designed to efficiently compare e-mails to detect potential SPAM e-mails (Cotten, col. 2, lines 21-33). In particular, the problem with most SPAM mail is that the same unsolicited and unwanted text is sent in bulk from multiple e-mail addresses, such that the identity of the sender or origin of the e-mail is not relevant, but detecting the redundancy of the same unsolicited text and eliminating unsolicited e-mail is relevant (see Cotten, col. 2, lines 28-33). In Cotten, unsolicited emails are identified by calculating a checksum for the text after stripping an e-mail of origin identifiers (Cotten, col. 2, lines 21-33). While a checksum may allow the non-origin identifying text of an e-mail to be compared with the checksums of other e-mails to trace whether there is repetition among the text of e-mails, the checksum does not promote traceability of the origin of an e-mail. In fact, the problem solved by Cotten, of efficiently comparing the text of multiple e-mails to find repetition, is advanced by eliminating origin identifiers included in the e-mail when the e-mail is received. Therefore, because Cotten does not teach watermarking, the application of watermarking, and does not teach a system that if modified would successfully apply or need to apply a watermark indicating the origin of an e-mail, Applicants respectfully note that the Examiner's conclusion that one would be motivated to modify Cotten to use the distinguishable watermark of Zhao because a watermark allows a message entry to be traceable is not well founded. As a result, Cotten in view of Zhao does not teach applying a distinguishable watermark to a plurality of message entries within a messaging session.

Cotten does not teach recording said plurality of message entries with said distinguishable watermark applied, such that an origin of said plurality of message entries is traceable according to said distinguishable watermark

In addition, the Examiner cites Cotten as teaching recording said plurality of message entries with said distinguishable watermark applied, such that an origin of said plurality of message entries is traceable according to said distinguishable watermark at col. 2, lines 41-47. [Office Action, p. 3] In particular, the Examiner cites col. 2, lines 41-47 as teaching "each signature being sent to a storage database comparator." Col. 2, lines 41-47 of Cotten teach:

> "Thus a digital signature detector operating with a designated flow of e-mail sends each signature to a storage data-base comparator, which checks for uniqueness of the signature and for an initial data-base entry creates an unwanted e-mail (SPAM) signal to send to the subscribing accounts for local storage used for rejecting SPAM at authorized facilities."

Applicants assert, however, that Cotten does not teach recording said plurality of message entries with said distinguishable watermark applied, such that an origin of said plurality of message entries is traceable according to said distinguishable watermark. In particular, Applicants assert that Cotten teaches storing the numerical checksum identifier for e-mail text, where the numerical identifier is stored for the purpose of comparison with the numerical identifiers of other e-mails (see Cotten, col. 2, lines 21-33). Storing a numerical identifier for e-mail text does not teach storing a watermarked message entry. In contrast, the present invention teaches storing watermarked message entries for the purpose of enabling the origin of the watermarked message entries to be traced according to the distinguishable watermarks.

In conclusion, for the foregoing reasons, Applicants respectfully assert that prima facie obviousness is not established for claims 1, 14, and 25 because at least one element of each of claims 1, 14, and 25 is not taught or suggested by Cotten or Zhao, separately or in combination under 35 U.S.C. §103(a). Because a prima facie case of obviousness is not established, Applicants respectfully request that Examiner reverse the rejection of claims 1, 14, and 25 and allow the claims.

Claims 2-5, 8-13, 15, 16, 19-24, 26, 27, and 30-35

In addition, because prima facie obviousness is not established for claims 1, 14, and 25, at least by virtue of their dependency on claims 1, 14, and 25, Cotten and Zhao, either alone or in combination, does not teach or suggest the features of dependent claims 2-5, 8-13, 15, 16, 19-24, 26, 27, and 30-35 under 35 U.S.C. §103(a). Because a prima facie case of obviousness is not established for claims 2-5, 8-13, 15, 16, 19-24, 26, 27, and 30-35, Applicants respectfully request allowance of claims 2-5, 8-13, 15, 16, 19-24, 26, 27, and 30-35.

Claims 36-50

Independent method claim 36, which is representative of independent system claim 41 and independent computer program product claim 46, with regard to similarly recited subject matter, reads as follows:

> 36. (Original) A method for participating in a messaging session, said method comprising the steps of:
>
> participating in a messaging session by receiving a plurality of messaging entries from a plurality of users participating in said messaging session; and
>
> receiving a recording of said messaging session, wherein said plurality of message entries for said messaging session are watermarked, such that use of said recording of said messaging session is traceable according to a watermark.

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. In particular, in establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In addition, in establishing a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that the Examiner does not show and the references do not teach or suggest, separately or in combination, receiving a recording of said messaging session, wherein said plurality of message entries for said messaging session are watermarked, such that use of said recording of said messaging session is traceable according to a watermark.

The Examiner cites Cotten as teaching receiving a recording of said messaging session, wherein said plurality of message entries for said messaging session are watermarked, such that use of said recording of said messaging session is traceable according to a watermark at col. 3, lines 25-31. [Office Action, p. 7] Col. 3, lines 25-31 read as follows:

> As the e-mail addressed to this particular subscriber flows through the e-mail path from Internet Operations 15 to the e-mail subscriber server 17, SPAM is detected at the local SPAM Detector Station 16, which typically also stores the signature identification codes of currently active bulk mail messages."

First, Cotten does not teach receiving a recording of said messaging session, wherein said plurality of message entries for said messaging session are watermarked, such that use of said recording of said messaging session is traceable according to a watermark because Cotten does not teach "watermarked" message entries of a messaging session. As previously described with reference to claim 1, "watermark" should be defined to require an affixed identifier of origin. Cotten's "signature identification codes" identify the checksum of the non-origin identifying text of an e-mail (Cotten, col. 2, lines 17-33). When an e-mail message is identified as a bulk e-mail, the checksum, termed as a "signature identification code" of the e-mail is sent to SPAM detection stations so that those stations can compare the checksum of the non-origin identifying text of current e-mail messages with the identified bulk e-mail checksums (Col. 3, lines 25-31). Thus, Cotten teaches detecting and storing checksums of e-mails. Detecting and storing checksums does not teach receiving a recording of a messaging session. In addition, detecting and storing checksums does not teach receiving the messaging session recording where the messages of the messaging session are watermarked, or affixed an identifier that enables tracing of the origin of the message entries.

Second, Cotten does not teach receiving a recording of said messaging session, wherein said plurality of message entries for said messaging session are watermarked, such that use of said recording of said messaging session is traceable according to a watermark because Cotten does not teach that "the use of the recording of the messaging session is traceable according to a watermark." As previously asserted, Cotten actually only teaches detecting and storing checksums, not receiving recordings of messaging sessions. Cotten further does not teach a watermark affixed to a recording of a messaging session that enables tracing of the use of the

recording. In particular, Cotten does not teach a watermark affixed to a messaging session that is updated to indicate the use of the recording of the messaging session.

In addition, Applicants note that claims 36, 41, and 46 are independent claims rejected under 35 U.S.C. 103(a) in view of the combination of Cotten and Zhao, however, the Examiner does not point out any teaching of Zhao that teaches any element of claims 36, 41, and 46. Applicants note that during the telephone interview of February 1, 2005, Applicants noted the lack of citation of Zhao with reference to claims 36, 41, and 46 and the Examiner responded that the rejection should have included arguments of how Zhao teaches claims 36, 41, and 46 similar to those cited against claim 1. Applicants respectfully assert, however, that even if the Examiner were to cite Zhao in combination with Cotten to teach watermarked message entries, Cotten does not teach the other elements of claims 36, 41, and 46 and there is no motivation, either in the references or what is known in the art to combine Cotten in view of Zhao, and therefore the combination of Cotten and Zhao would not each all the elements of claims 36, 41, and 46.

In conclusion, for the foregoing reasons, Applicants respectfully assert that prima facie obviousness is not established for claims 36, 41, and 46 because at least one element of each of claims 36, 41, and 46 is not taught or suggested by Cotten or Zhao, separately or in combination, under 35 U.S.C. §103(a). Because a prima facie case of obviousness is not established, Applicants respectfully request that Examiner reverse the rejection of claims 36, 41, and 46 and allow the claims. In addition, because prima facie obviousness is not established for claims 36, 41, and 46, at least by virtue of their dependency on claims 36, 41, and 46, Cotten and Zhao, either alone or in combination, does not teach or suggest the features of dependent claims 37-40, 42-45, and 47-50 under 35 U.S.C. §103(a). Because a prima facie case of obviousness is not established for claims 37-40, 42-45, and 47-50, Applicants respectfully request allowance of claims 37-40, 42-45, and 47-50.

Claim 51-53

Independent method claim 51, which is representative of independent system claim 52 and independent computer program product claim 53, with regard to similarly recited subject matter and rejection, reads as follows:

51.(Original) A method for protecting received message entries, said method comprising the steps of:

receiving a message entry in association with a messaging session at a client messaging system; and

applying a watermark to said message entry, such that an origin of said message entry is traceable to said client messaging system.

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. In particular, in establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In addition, in establishing a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that the Examiner does not show and the references do not teach or suggest, separately or in combination, applying a watermark to said message entry, such that an origin of said message entry is traceable to said client messaging system.

The Examiner cites Cotten as teaching applying a watermark to said message entry, such that an origin of said message entry is traceable to said client messaging system at col. 2, lines 28-30. [Office Action, p. 8] Col. 2, lines 28-30 teach:

> "After detection, a numerical signature identification code for that bulk message is established, preferably by calculating a checksum using a 16-bit cyclic redundancy check."

First, Cotten does not teach applying a watermark to said message entry, such that an origin of said message entry is traceable to said client messaging system because Cotten does not teach a "watermark". In particular with reference to the arguments relating to Claim 1, Applicant asserts that a "watermark" includes the characteristics of being an origin identifier and being affixed. The checksum calculation taught by Cotten, when viewed within the teachings of Cotten as a whole including col. 2, lines 17-27, teaches a numerical identifier for the text of an e-mail, stripped of origin identifiers. A checksum calculation of the non-origin identifying text of an e-mail is not an identifier of the origin of an e-mail. In contrast, the watermark of the present invention is applied to a message entry to indicate origin ("such that the origin of said message

entry is traceable to said client messaging system.") Where Cotten does not teach determining an origin identifier for a message entry, Cotten fails to teach a "watermark".

Second, Cotten does not teach applying a watermark to said message entry, such that an origin of said message entry is traceable to said client messaging system because Cotten does not teach "applying a watermark". Where Cotten teaches establishing a numerical "signature identification code" for a bulk message in col. 2, lines 28-30, when read in the context of col. 2, lines 17-27, the numerical "signature identification code" is the checksum calculated from the text of e-mail that has been determined to be bulk e-mail. The "establishing" of the numerical "signature identification code" is the result of detecting "at least two e-mail messages identified containing the same non-address contents being sent to different e-mail addresses" (Cotten, col. 2, lines 17-38). The established numerical "signature identification code" is the checksum of the non-origin identifying text of an e-mail and once it is established as representing bulk e-mail, the numerical "signature identification code" is communicated to subscribers' reception stations so that the stations can delete e-mails with checksums that match the numerical "signature identification code". However, even if a checksum calculated for the contents of an e-mail were considered an origin identifier, the detection of a checksum representative of bulk e-mail and the distribution of that checksum does not include applying or affixing that checksum to e-mails. Thus, where Cotten fails to teach the application of an origin identifier to a message entry, Cotten fails to teach "applying a watermark."

In addition, Applicants note that claims 51, 52, and 53 are independent claims rejected under 35 U.S.C. 103(a) in view of the combination of Cotten and Zhao, however, the Examiner does not point out any teaching of Zhao that teaches any element of claims 51, 52, and 53. Applicants note that during the telephone interview of February 1, 2005, Applicants noted the lack of citation of Zhao with reference to claims 51, 52, and 53 and the Examiner responded that the rejection should have included arguments of how Zhao teaches claims 51, 52, and 53 similar to those cited against claim 1. Applicants respectfully assert, however, that even if Zhao were combined with Cotten to teach a watermark or applying a watermark, as asserted with reference to Claim 1, there is no motivation, either in the references or what is known in the art to combine

Cotten in view of Zhao, and that the combination would not teach all the elements of claims 51, 52, and 53.

In conclusion, for the foregoing reasons, Applicants respectfully assert that prima facie obviousness is not established for claims 51, 52, and 53 because at least one element of each of claims 36, 41, and 46 is not taught or suggested by Cotten or Zhao, separately or in combination, under 35 U.S.C. §103(a). Because a prima facie case of obviousness is not established, Applicants respectfully request that Examiner reverse the rejection of claims 51, 52, and 53 and allow the claims.

Claims 54-56

Independent method claim 54, which is representative of independent system claim 55 and independent computer program product claim 56, with regard to similarly recited subject matter and rejection, reads as follows:

> 54. (Original) A method for protecting message transmissions, said method comprising the step of:
>
> detecting a new message entry entered at a client messaging system; and
>
> applying a watermark to said new message entry prior to transmission for distribution within a messaging session, such that an origin of said new message entry is traceable to said client messaging system.

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. In particular, in establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In addition, in establishing a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that the Examiner does not show and the references do not teach or suggest, separately or in combination, applying a watermark to said new message entry prior to transmission for distribution within a messaging session, such that an origin of said new message entry is traceable to said client messaging system.

The Examiner cites Cotten as teaching applying a watermark to said new message entry prior to transmission for distribution within a messaging session, such that an origin of said new message entry is traceable to said client messaging system at col. 2, lines 28-30. [Office Action, p. 8] Both claims 51 and 54 teach "applying a watermark to a message entry", claim 54 however, teaches "applying a watermark to a new message entry prior to transmission for distribution within a messaging session." Regardless, for the same reasons as are asserted with reference to claim 51, Cotten does not teach "a watermark" or "applying a watermark" and therefore Cotten does not teach applying a watermark to said new message entry prior to transmission for distribution within a messaging session. In addition, because Cotten only teaches calculating, storing, and distributing checksums that identify the contents of bulk e-mails, Cotten does not teach applying an identifier to a message entry that enables tracing of the origin of the message entry to a particular client messaging system, prior to enabling distribution of the message entry within a messaging session.

In addition, Applicants note that claims 54, 55, and 56 are independent claims rejected under 35 U.S.C. 103(a) in view of the combination of Cotten and Zhao, however, the Examiner does not point out any teaching of Zhao that teaches any element of claim 54, 55, and 56. Applicants note that during the telephone interview of February 1, 2005, Applicants noted the lack of citation of Zhao with reference to claims 54, 55, and 56 and the Examiner responded that the rejection should have included arguments of how Zhao teaches claims 54, 55, and 56similar to those cited against claim 1. Applicants respectfully assert, however, that even if Zhao were combined with Cotten to teach a watermark or applying a watermark, as asserted with reference to Claim 1, there is no motivation, either in the references or what is known in the art to combine Cotten in view of Zhao, and that the combination would not teach all the elements of claims 54, 55, and 56.

2. Claims 6, 7, 17, 18, 28, and 29

Claims 6, 7, 17, 18, 28, and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cotten (US Patent Number 6,330,590) in view of Zhao (US Patent Number 6,754,822) and further in view of Rodriguez et al. (US Patent Number 6,650,761). The rejection

is respectfully traversed. In particular, the Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. Because the Examiner does not carry the burden of proving a prima facie case of obviousness for claims 6, 7, 17, 18, 28, and 29, the rejection should be withdrawn and the claims should be allowed.

Dependent method claims 6 and 7, which are representative of dependent system claims 17 and 18 and dependent computer program product claims 28 and 29, with regard to similarly recited subject matter and rejection, reads as follows:

> 6. (Original) The method for recording a messaging session according to claim 1, said step of applying a distinguishable watermark further comprising the step of:
>
> applying a graphical watermark to said plurality of message entries within said messaging session.
>
> 7. (Original) The method for recording a messaging session according to claim 1, said step of applying a distinguishable watermark further comprising the step of:
>
> applying an audible watermark to said plurality of message entries within said messaging session.

The Examiner carries the burden of proving a prima facie case of obviousness for a 103(a) rejection. In particular, in establishing a prima facie case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). In addition, in establishing a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully assert that the Examiner does not show and the references do not teach or suggest, separately or in combination, applying a graphical watermark to said plurality of message entries within said messaging session or applying an audible watermark to said plurality of message entries within said messaging session.

The Examiner cites Cotten as failing to teach "the use of a graphical and audible watermark" as taught in claims 6 and 7. [Office Action, p. 9] The Examiner cites Rodriguez, however, as teaching:

> "systems using such optical interfaces to control computers, and to navigate over or act as portals on networks (see abstract). Rodriguez teaches the use of an audio watermark (col. 44, lines 66-67) and a graphical watermark (col. 53, lines 51-58)." [Office Action, p. 9]

The Examiner then concludes that:

> "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Cotten in view of Rodriguez to use a graphical and audible watermark. One would be motivated to do so because it would allow for different options of visible watermarking." [Office Action, p. 9]

Rodriguez describes "embedding auxiliary data into music (i.e. watermarking)" where the watermark is may include multiple types of information, such as "a digital object identifier to uniquely identify the work" (Rodriguez, col. 42, lines 15-16, 52-58). Col. 44, lines 66-67 of Rodriguez teach that "[a]nother data field that can be included in an audio watermark is a rating that indicates age-appropriateness." In addition, col. 53, lines 50-58 teach:

> "According to another aspect of the invention, a production tool is provided that facilitates the selection and embedding of dynamically-changing watermark data. One such embodiment is a software program having a user interface that graphically displays the different watermark fields that are being embedded in a work, and presents a library of data (textually or by icons) that can be inserted into each field, and/or permits the user to type in data to be encoded."

First, Cotten in view of Rodriguez does not teach applying a graphical watermark or audible watermark to said plurality of message entries within a messaging session because none of Cotten, Zhao, and Rodriguez teaches applying a watermark to message entries. As previously described with reference to claim 1, Cotten in view of Zhao does not teach applying a watermark to message entries. In addition, Rodriguez teaches applying a watermark to a music file in a digital format, which does not teach applying a watermark to a message entry. Therefore, because Cotten, Zhao and Rodriguez, separately or combination, do not teach applying a watermark to message entries, the references also do not teach applying a graphical watermark or audible watermark to said plurality of message entries within a messaging session.

Second, Cotten in view of Rodriguez does not teach applying a graphical watermark or audible watermark to said plurality of message entries within a messaging session because there is no motivation in Cotten, Zhao, and Rodriguez or in the knowledge generally available in the art to combine Cotten, Zhao and Rodgriguez, nor does the combination teach the claimed

invention. Applicants respectfully assert that when the references and claims 6 and 7 as combined with claim 1 are considered as a whole, it would not have been obvious to one of ordinary skill in the art at the time of the invention to modify Cotten in view of Rodriguez because Cotten's system is not concerned with identifying the origin of an email. Cotten's system is designed to efficiently compare e-mails to detect potential SPAM e-mails (Cotten, col. 2, lines 21-35). In particular, the problem with most SPAM mail is that the same unsolicited and unwanted text is sent in bulk from multiple e-mail addresses, such that the identity of the sender or origin of the e-mail is not relevant, but detecting the redundancy of the same unsolicited text and eliminating unsolicited e-mail is relevant. E-mail messages are parsed to extract the non-origin identifying text and calculate a checksum for that text. (Cotten, col. 2, lines 21-35). The checksum is not applied to the e-mail message and Cotten teaches storing and distributing the checksum, not the e-mail message (Cotten, col. 2, lines 21-47). The goal of Cotten is detecting patterns, not detecting uniqueness. In contrast, the present invention teaches applying a watermark, which is applied to provide an identifier of origin and uniqueness. Further, Rodriguez teaches a system for applying watermarking to music files so that each music file is uniquely identifiable (Rodriguez, col. 42, lines 15-16, 52-58). Thus, where Cotten teaches parsing the text of multiple e-mails to determine patterns among e-mails already in transit, and Rodriguez teaches applying watermarks to uniquely identify each music file before distribution, Cotten and Rodriguez teach away from one another. Since Rodriguez and Cotten teach away from each other, there is no motivation to combine these references. As a result, applying a graphical watermark or audible watermark to said plurality of message entries within a messaging session is not obvious under Cotten in view of Rodriguez under 35 U.S.C. 103(a).

Conclusion

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment. Further, Applicants reiterate the request for a telephone conference with the Examiner at the Examiner's earliest convenience.

Respectfully submitted,

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